

DETAILED ACTION

Response to Amendment

In response to the amendment filed 19 march 2010, the following is placed in effect.

The rejection of claims 9 and 12-18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwata et al (US 5,430,080), is hereby expressly withdrawn.

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). See also AK Steel Corp. v. Sollac, 344 F.3d 1234, 1240-41,68 USPQ2d 1280, 1283-84 (Fed. Cir. 2003). Note 2111.03 [R-3] **Transitional Phrases.** Applicants have not established what "consisting essentially of" may exclude/include.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 12-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Abe et al (US 5,218,048).

The reference to Abe et al shows the contemplated blend of "a higher α -olefin" polymer which may contain "50 mol% or more" of the monomer. The reference shows the higher alpha olefin homopolymers at column 3 (lines 20-35). The paragraph bridging column 3 to column 4 teaches the use of the thermoplastic resin. Further, note column 3 (lines 56-62) for the molecular weight which would be expected to be within the range of claim 4. As regards the MWD of "4.0 or less" there is no indication that the value would or could be higher than one.

The reference shows the resin blend, as pointed out above. The employment of a stereoregular homopolymer of 1-decene would be within the purview of the reference, absent reasoning as to why it would not be. The molecular weight range and molecular weight distribution would also be expected to be within the ranges recited. A skilled artisan would have a high level of expectation of success following the teachings of the reference to arrive at the instantly claimed invention.

As such, the instant claims are deemed to be at least obvious, if not anticipated, by the teachings of the reference.

Response to Arguments

Applicant's arguments filed 19 March 2010 have been fully considered but they are not persuasive.

With regard to the rejection of claims 9 and 12-18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Abe et al (US 5,218,048), applicants argue the application shows unexpected results. As regards the Comparative examples therein. However, the reference to Abe et al shows essentially what is recited herein, with no comparison provided thereover. Further, applicants opine that since the thrust of the Abe et al reference is not directed to "why the specific mixture of a propylene polymer (1A) and a higher α -olefin polymer (3) should be chosen or that any improvement could be achieved by mixing them." Patentees do not have to recognize each and every improvement, observable or inherent. Applicants further opine, "(t)he description provided at column 3, lines 20 to 26 of Abe merely enumerate conceivable α -olefin monomers." This is all that is sufficient to anticipate this feature is the disclosure thereof. Applicants continue "Abe fails to disclose or suggest that the higher α -olefin polymer must be used to produce the composition described therein." The disclosure is sufficient. Applicants argue the patentability of the claims on inherent features of the composition. Applicants have

failed to provide any comparative data to differentiate over the teachings of the reference. This is true whether applicants argue an improved heat resistance, elastic modulus, or other feature which a skilled artisan would know to be inherent in the composition or expected from the disclosure. Since the compositions may be identical, as disclosed, these features would be expected.

The claims are drawn to a composition, per se. the manner of preparation of any or all of the constituents does not provide patentable support in a composition claim, even in product-by-process situations, which is not the case here. Since all other parameters are shown other than the stereoregularity index M2 as recited, there appears to be great coincidence that the compositions would possess same. Applicants have failed to differentiate through any comparative data.

Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmm

16 April 2010